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EXAMINER

LEZAK, ARRIENNE M

ART UNIT PAPER NUMBER

2143

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,607

Applicant(s)

CHERRY, DARREL D.

Examiner

Arrienne M. Lezak

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,8,9,11-16 and 21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6,8,9,11-16 and 21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Applicant's arguments with respect to claims 6, 8, 9, 11-16 & 21 have been considered but are moot in view of the new ground(s) of rejection. Examiner notes that no claims have been amended, cancelled or added since issuance of the last Office Action dated 3 June 2005.

Response to Amendment

2. The declaration filed on 16 August 2005 under 37 CFR 1.131 is sufficient to overcome the Fu '234 reference; however, Examiner finds that Applicant's claimed invention remains unpatentable in light of the new grounds of rejection as noted herein.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 21 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, Examiner finds the claim language, "communicating, from the PDA" to be confusing as no indication is made as to where the information from the PDA is going other than to the network printer. Additionally, the claim language indicates that a document is communicated to the network printer "without further use of the PDA, the information for printing the document being

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communicated to the network printer", and no indication is made as to where this information is coming from other than the PDA. Correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6, 11-13, 15, 16 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over extensive consideration of US Patent US 6,738,841 B1 to Wolff.

7. Regarding Claims 6, 11-13, 15, 16 & 21, Wolff discloses a print method and system for use with an intranet, (Col. 4, lines 56-64 & Col. 5, lines 26-30), the intranet being configured to store information corresponding to documents available for printing remotely, (Fig. 9 & Col. 2, lines 29-62), said print system comprising:

- communicatively coupling a personal digital assistant (PDA), (per pending Claim 13), to an intranet, the intranet providing access to print information, (document retrieval system), corresponding to documents available for printing, (Fig. 9; Col. 8, lines 32-67; & Col. 9, lines 1-30);
- receiving document reference information corresponding to each document available for printing (from the document retrieval system), (Fig. 9; Col. 8, lines 32-67; & Col. 9, lines 1-30),

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- storing document reference information with the PDA, (Col. 8, lines 33-47), (Examiner notes that as a PDA has a memory/storage capability, storage of document reference information on the PDA would have been obvious for purposes of transportation convenience at a remote location); and
- displaying, on the PDA, for the user, information corresponding to each document available for printing, the information being selectable such that selection of first information associated with a first document available for printing enables identification of the first document as a document to be printed at the network printer, (Fig. 9; Col. 8, lines 32-67; & Col. 9, lines 1-30), (Examiner notes that it is well-known that a PDA is capable of displaying information, which information is selectable).
- wherein the step of enabling retrieval of printer information, (per pending Claim 15), comprises the steps of communicatively coupling a personal digital assistant (PDA) to the network printer on the intranet/Internet, (Fig. 9; Col. 8, lines 32-67; & Col. 9, lines 1-30);
- receiving printer information, (IP address – per pending Claim 6), from the network printer; and storing the printer (driver) information with the PDA, (Fig. 9; Col. 5, lines 21-49; Col. 8, lines 32-67; & Col. 9, lines 1-30), (Examiner notes that as a PDA has a memory/storage capability, storage of printer information on the PDA would have been obvious for purposes of transportation convenience at a remote location. Additionally, Examiner

notes that devices on any network require an address, and as Wolff teaches printers on the Internet, the use of an IP address for printer identification and access purposes would have been obvious (if not inherent)); and

- communicating, from the PDA, (remote print request system), to the document retrieval system, the printer information and the document reference information corresponding to a document to be printed such that the information for printing the document is communicated to the (remote – per pending Claims 12 & 15) network printer via the intranet and the Internet with the document being printed at the (remote) network printer, directly from the document retrieval system without further use of the remote print request system, wherein the document retrieval system retrieves print information corresponding to a document to be printed in response to receiving document reference information from the remote print request system, (per pending Claim 16), (Fig. 9; Col. 8, lines 32-67; & Col. 9, lines 1-30).

Thus, Claims 6, 11-13, 15, 16 & 21 are unpatentable over considerable consideration of the teachings of Wolff.

8. Claims 8, 9 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of US Patent US 6,738,841 B1 to Wolff in view of US Patent Pub. No.: US 2002/0085515 A1 to Jaynes.

9. Regarding Claims 8, 9 & 14, Wolff discloses a method, system and computer-readable medium for remotely printing a document, (Fig.9), wherein access is permitted to documents over a network, (Col. 5, lines 25-39), wherein Examiner notes that though not specifically noted within Wolff, accessing documents over a network would obviously require some sort of security or authorization process. That noted, Examiner additionally provides the Jaynes reference. Jaynes teaches receiving, storing and providing an authorization code via the PDA, (per pending Claim 9), wherein the step of providing [printer – per Wolff] information comprises the step of the [document] retrieval system providing the authorization code to the intranet, (remote print request system), such that the user may be identified as being authorized access [to request printing of a document at the network printer – per Wolff], (per pending Claims 8 & 14), (Jaynes – paragraph #0031).

10. The motivation to combine the teachings of Wolff and Jayne is found within Jaynes, which notes a need to provide information to a user, (PDA over a network), which information is relevant to a specific physical object in the vicinity of the user, (i.e.: bank account, etc.), (paragraph #006). Examiner notes that user, (i.e.: bank account, etc.) information is well known to be private information requiring a secure transmission/transfer process. Additionally, Examiner notes that as a PDA has a memory/storage capability, storage of an authorization code on the PDA would have been obvious for purposes of security and access authorization when transmitting/receiving from a remote location. Thus, Claims 8, 9 & 14 are unpatentable over the combined teachings of Wolff and Jaynes.

Response to Arguments

11. Applicant's arguments filed 16 August 2005, have been fully considered but they are not persuasive as they pertain to the patentability of Applicant's claimed invention. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

12. Applicant asserts that newly amended/added claims are patentably distinct from the prior art because they recite additional limitations enumerating direct communication between the document retrieval system and the printer without additional interaction with the remote print request system. Examiner disagrees finding that the combined teachings of Wolff and Jaynes disclose the same, as noted herein above. Thus, Examiner finds the combined teachings of Wolff and Jaynes to fully encompass and anticipate all claims as enumerated by Applicant.

Conclusion

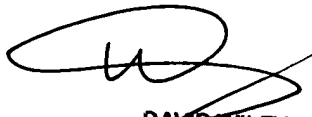
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
Examiner
Art Unit 2143

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